



CPA/1753/5/23/02
#14 CPA



CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing.
(Only for Continuation or Divisional applications under 37 CFR 1.53(d))

CHECK BOX, if applicable:
☐ **DUPLICATE**

Address to: Commissioner for Patents Box CPA Washington, DC 20231	Attorney Docket No.	03500.013980
	First Named Inventor	SATORU MOTOHASHI
	Examiner Name	Chris D. RoDee
	Group Art Unit	1753
	Express Mail Label No.	

This is a request for a ☒ continuation or ☐ divisional application under 37 CFR 1.53(d), (continued prosecution application (CPA)) of prior application number 03/428,453, filed on October 28, 1999, entitled ELECTROPHOTOGRAPHIC PHOTOSENSITIVE MEMBER AND IMAGE FORMING APPARATUS USING THE SAME.

NOTES

FILING QUALIFICATIONS: The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR § 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. A Notice will be placed on a patent issuing from a CPA, except for reissues and designs, to the effect that the patent issued on a CPA and is subject to the twenty-year patent term provisions of 35 U.S.C. § 154(a)(2). Therefore, the prior application of a CPA may have been filed before, on or after June 8, 1995.

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 CFR § 1.53(d), but must be filed under 37 CFR § 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR § 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR § 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR § 1.78(a).

1. ☒ Enter the unentered amendment previously filed on March 21, 2002 under 37 CFR § 1.116 in the prior nonprovisional application.
2. a. ☒ A preliminary amendment is enclosed.
b. ☐ The applicant(s) presently intend(s) to file additional papers in this case shortly. Should the Examiner take this case up for action before receiving such papers, it is respectfully requested that the Examiner contact the attorneys for the applicant(s).
3. This application is filed by fewer than all the inventors named in the prior application, 37 CFR § 1.53(d)(4).
a. ☐ DELETE the following inventor(s) named in the prior nonprovisional application:

b. ☐ The inventors to be deleted are set forth on a separate sheet attached hereto.
4. ☐ An Associate Power of Attorney is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
a. ☐ PTO-1449
b. ☐ Copies of IDS Citations

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CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS (37 CFR § 1.16(c) or (j))	7-20 =	0	X \$ 18.00 =	\$.00
	INDEPENDENT CLAIMS (37 CFR § 1.16(b) or (i))	3-3 =	0	X \$ 84.00 =	\$.00
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR § 1.16(d))			\$280.00 =	\$
				BASIC FEE (37 CFR § 1.16(a))	\$ 740.00
	Total of above Calculations =				\$
	Reduction by 50% for filing by small entity (Note 37 CFR §§ 1.9, 1.27, 1.28).				
	TOTAL =				\$

6. Small entity status

- a. ☐ A Small entity statement is enclosed
- b. ☐ A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
- c. ☐ Is no longer claimed.

7. ☐ Small entity status: Applicant claims small entity status. See 37 CFR § 1.27.

8. ☒ A check in the amount of \$ 740.00 is enclosed.

9. The Commissioner is hereby authorized to credit overpayments or charge deficiencies in the following fees to Deposit Account No. 06-1205:

- a. ☒ Fees required under 37 CFR § 1.16.
- b. ☒ Fees required under 37 CFR § 1.17.
- c. ☐ Fees required under 37 CFR § 1.18.

10. ☐ Applicant requests suspension of action under 37 CFR § 1.103(b) for three months. (Fee of \$130.00 required under 37 CFR § 1.17(i) is enclosed).

11. a. ☐ Receipt For Facsimile Transmitted CPA (PTO/SB/29A).

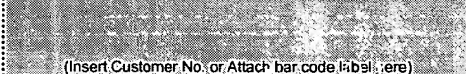
b. ☒ Return Receipt Postcard (Should be specifically itemized. See MPEP 503).

12. ☐ Other _____

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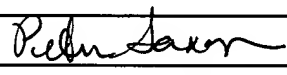
NOTE: The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below

13. NEW CORRESPONDENCE ADDRESS

☐ Customer Number or Bar Code Label  or ☐ New correspondence address below
(Insert Customer No. or Attach bar code label here)

NAME					
ADDRESS					
CITY	STATE	ZIP CODE			
COUNTRY	TELEPHONE	FAX			

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

NAME	PETER SAXON
SIGNATURE	
REGISTRATION NO.	24947
Date	May 23, 2002



5/23/02
#A/Response

03500.013980

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: C. RoDee
SATORU MOTOHASHI ET AL.)
: Group Art Unit: 1753
Application No.: 09/428,453)
:
Filed: October 28, 1999)
:
For: ELECTROPHOTOGRAPHIC)
PHOTOSENSITIVE MEMBER :
AND IMAGE FORMING)
APPARATUS USING THE :
SAME) May 21, 2002

Commissioner for Patents
Washington, D.C. 20231

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PRELIMINARY AMENDMENT

Sir:

In the Advisory Action mailed April 17, 2002 (Paper No. 13), the Examiner maintained the Rule 112 first paragraph rejection concerning the charging member because the passages on pages 1 and 2 of the specification relied upon were said to be directed to the prior art and not to the claimed invention. Applicants wish to address the Examiner's contention in this response.

It will be demonstrated that the disclosure on pages 1 and 2 stating that the charge roller 3 is a charging means also refers to the present claimed invention. The phrase "charging means" was explicitly disclosed in connection with Fig. 2. However, on

specification page 10, lines 10-18 in connection with a description of the present invention Applicants disclosed as follows: "Incidentally, a construction of an image forming apparatus having the photosensitive drum 2 is the same as that shown in Fig. 2, and duplicated explanation thereof will be omitted." This is a clear indication that Applicants intended that the description of Fig. 2 be utilized in the Figures illustrating the present invention and that duplicated explanations of each of the elements of Fig. 2 by the corresponding elements of the inventive Figures were omitted in order to reduce redundant explanations.

On specification page 22,, there is a disclosure of the elements in Fig. 6. On page 23, line 1, there is disclosure of charge roller 3. Clearly, the explanation that charge roller 3 is a charging means is to be imported from the disclosure on page 1 which provides a charge roller 3 is a charging means. This logical conclusion is confirmed by the disclosure on specification page 27.

On specification page 27, lines 2-8, it is disclosed that in the second embodiment, as illustrated in Fig. 7, there is a charge roller 3 and a developing means 6 (which is explained in connection with the first embodiment). On page 27, lines 9-12 it is further recited: "as explained in connection with Fig. 2, the developing means 6 includes" (emphasis supplied). This is another instance where Applicants have imported the explanation with regard to the elements in Fig. 2 into the inventive figures. On page 27, lines 2-8, Applicants have referred to both charge roller 3 and developing means 6 in the same sentence and in the next paragraph have tied the developing means 6 to the disclosure of Fig. 2.

Accordingly, it is submitted that it is immediately clear to one of ordinary skill in the art in reading the specification that charging roller 3 in Fig. 2 (which is described as a charging means), is the same element disclosed in Figs. 4, 6 and 7 of the present claimed invention. Therefore, one of ordinary skill would immediately understand that roller 3 in Figs. 4, 6 and 7 is the same as the charging means as employed in conjunction with Fig. 2. Accordingly, the Examiner is requested to reconsider his position and to withdraw the objection based on Rule 112, first paragraph.

An early and favorable action on the merits is respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Attorney for Applicants

Registration No.

24947

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